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Attorney Docket No. VPI/00-117

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants : Jean-Damien Charrier et al.
Application No. : 09/877,832 Confirmation No. : 9982
Filed : June 7, 2001
For : CASPASE INHIBITORS AND USES THEREOF
Group Art Unit : 1624
Examiner : Venkataraman Balasubramanian

AUG 05 2002
TECH CENTER 1000/0000

Cambridge, Massachusetts
July 29, 2002

Hon. Commissioner for Patents
Washington, D.C. 20231

AMENDMENT AND REPLY TO RESTRICTION REQUIREMENT

Sir:

This is in reply to the June 27, 2002 Restriction Requirement in the above-identified application. The time for reply to this Restriction Requirement is up to and including July 29, 2002 (July 27 and July 28 being a Saturday and a Sunday, respectively). Accordingly, this reply is timely filed.

REMARKS

The Examiner has required restriction of the claims under 35 U.S.C. § 121 into one of the following Groups:

Group I: Claims 1-13, wherein "X₂-X₁ is choice 1 and choice 4";
Group II: Claims 1-13, wherein "X₂-X₁ is choice 3, choice 5 and choice 7"; and

Group III: Claims 1-13, wherein "X₂-X₁ is choice 2, choice 6 and choice 8."

The Examiner contends that each of the Group I-III inventions is independent and distinct. Specifically, the Examiner contends that each Group is directed to heterocycles having different heterocyclic cores. The Examiner concludes that these Groups thus have different classifications and would require separate prior art searches. Applicants traverse

Applicants traverse the restriction on the basis of the procedures set forth in the Manual for Patent Examining Procedure ("MPEP"). The MPEP states that there are two criteria for a proper requirement of restriction. MPEP § 803. The first is that the inventions must be independent or distinct as claimed. The second is that there must be a serious burden on the Examiner if restriction is not required. The MPEP further states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." MPEP § 803.

Applicants submit that a search and examination of the pending claims could be made without serious burden. Each variable X₂-X₁ may be one of only two atoms - a carbon or a nitrogen. Thus, although the heterocycles of each Group are different, a search would involve varying merely two heteroatoms at two locations of the heterocyclic core. It should be routine

to conduct such a search. Therefore, there would be no serious burden for the Examiner to search the claims of Groups I-III together. For these reasons, applicants request that Group I-II be rejoined.

Applicants request that the Examiner examine Groups I-III together. If the Examiner does not agree with applicants' proposal to rejoin Groups I-III, applicants provisionally elect with traverse the claims of Group I for initial substantive examination. 37 C.F.R. § 1.143. This election is made expressly without waiver of applicants' rights to file for and obtain claims directed to the non-elected subject matter in divisional or continuing applications claiming priority and benefit from this application under 35 U.S.C. § 120.

In view of the above, applicants request that the Examiner examine claims 1-13 in this application. Applicants request favorable consideration and early allowance of the pending claims.

Respectfully submitted,



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